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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,942	08/01/2005	Philip Raymond Hankin	SWIN 3268	8700
7812	7590	08/23/2006	EXAMINER	
SMITH-HILL AND BEDELL, P.C. 16100 NW CORNELL ROAD, SUITE 220 BEAVERTON, OR 97006			LEWIN, ALLANA	
			ART UNIT	PAPER NUMBER
			3764	
DATE MAILED: 08/23/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/541,942	HANKIN, PHILIP RAYMOND	
	<b>Examiner</b>	<b>Art Unit</b>	
	Allana Lewin	3764	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 July 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 23-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-44 is/are rejected.
- 7) ☒ Claim(s) 35 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 July 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amended claims filed July 5<sup>th</sup>, 2005, which are the original claims that form the basis of the U.S. national stage application, are not identical to the claims from the International Preliminary Examination Report. Claims 1-22, rather than 1-31, from the International Preliminary Examination Report have been cancelled and replaced by claims numbered 23-44. Therefore, there is inconsistency with the claims that have been cancelled and the amended claims as well as overlap in claim numbering. Appropriate correction is required with the response to this Office action.

### ***Claim Objections***

2. Claim 35 is objected to because of the following informalities: in lines 1-2 the phrase 'the skid may is a dimpled or cross-hatched' is grammatically incorrect. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 34 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In line 3 of the claim, it is unclear what the phrase 'in order to

provide the exerciser' is intended to recite and it appears as though this claim is incomplete.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 23, 25-30, 35-41 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US Pat. No. 1,497,243) in view of Russell (US Pat. No. 4,603,851).

7. Martin discloses a foot exerciser comprising a 'skid' with a slide surface on one side (8) and a grip surface for engaging a user's heel on the other (note Figures 2 and 6), with the heel and exerciser being slidable upon a surface for exercise.

8. Martin fails to disclose the grip surface being deformable.

9. Russell discloses an exerciser for engagement by a user's feet and teaches the use of a grip surface (note Figure 1) comprising resilient pad members (12) that compressible or deformable and therefore allow 'compressive abutment' with the user's foot, and therefore inherently the heel as well, and provides a non-slip association there between when the user's foot and heel are placed on the device. Russell teaches that the compression of the pads during exercise provides the user's muscles with a high

level of activity (column 4, lines 65-68 to column 5, lines 1-3) and therefore provides beneficial and enhanced effects to the user.

10. Based on the teachings of Russell, it would have been obvious to one having ordinary skill at the time the invention was made to have utilized a deformable grip surface with the Martin device in order to provide a better and more enhanced level of exercise to the user which greatly increases the functionality and versatility of the device.

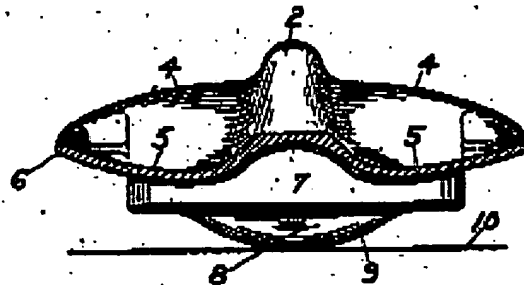
11. Regarding claims 25 and 26, Martin teaches the slide surface being curved (9) in both side-to-side and front to back directions (note Figures 1 and 3).

12. Regarding claim 27, Martin teaches that the device may be formed of one solid piece (column 3, lines 15-19) and, as best understood and seen from a cross section view of the device (note Figure 7), the device appears to be formed of a single form or unitary molding.

13. As to claim 28, the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, the limitation of the skid being stamped or machined has not been given patentable weight.

14. Regarding claims 29 and 30, Martin teaches the device being formed from plastics or metal (column 3, lines 11-19), with suitable metals including aluminum, brass, iron, etc. Therefore, the device is rendered suitable for heat sterilization as these various metals are capable of sustaining high temperatures at which heat sterilization occurs.

15. Furthermore, Martin discloses the device having a generally oblong shape (note Figure 2) with various depressions on the surface, particularly sockets (5) that enable the user's heels to be firmly planted on the device, and therefore, as best understood, comprehends Applicant's 'dimpled surface' to provide the grip. Additionally, Martin specifically teaches that the device may be made of rubber, which, by definition, comprehends Applicant's non-slip elastomeric material that is rubber based. As best seen in Figures 3 and 4 as well as highlighted in the figure below, Martin discloses the device having an upturned curved rim away from the slide surface which inherently prevents snagging of the exerciser during use due to its shape and form, and the upturned rim also providing sockets (5), which comprehend Applicant's 'dished configuration'.



16. Regarding claim 41, Martin fails to disclose the device incorporating a cushioning material between the grip and the slide surface.

17. Russell teaches the device having a base member (14) located between the top/grip surface and the bottom surface of the device (note cross section shown in Figure 2 and note Figure 4), and teaches the base member being an open cellular foam

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material, which comprehends Applicant's 'cushioning material'. This additional foam material provides greater compression to the device thereby imparting more substantial exercise activity to the user as this increases the degree to which the user's muscles are worked.

18. Therefore, based on the teachings of Russell, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have utilized a cushioning material between the grip and the slide surface in the Martin device so as to enable the user to attain a more rigorous, intensive and effective workout while using the device.

19. Regarding claim 43, the grip taught by Martin is recessed and shaped to engage and counter a user's limb (note Figure 6), with the recess comprising a socket or depression (5) and therefore facilitating a non-slip association between the grip and a portion of the user's limb as Martin teaches the user's heel being firmly planted in the sockets (column 2, lines 46-52).

20. Claims 23, 24, and 42 rejected under 35 U.S.C. 103(a) as being unpatentable over Maki (US Pat. No. 5,891,002) in view of Russell.

21. Maki discloses an exerciser comprising a 'skid' with a flat slide surface on one side (note Figure 10) and a grip surface for engaging the user's heel on the other (note Figure 5), the grip surface comprising friction strips (32) thereby providing a non-slip association between the grip and the user, and the heel and exerciser being slidable upon a surface for exercise. Maki further teaches the use of ribs via a frictional cover

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cap (48) to facilitate a preferred direction of slide for the exerciser (column 5, lines 44-49).

22. Maki fails to disclose the grip surface being deformable.

23. Russell discloses an exerciser for engagement with the user's feet and teaches the use of a grip surface (note Figure 1) comprising resilient pad members (12) that compressible or deformable and therefore allow 'compressive abutment' with the user's foot, and therefore inherently the heel as well. Russell teaches that the compression of the pads during exercise provides the user's muscles with a high level of activity (column 4, lines 65-68 to column 5, lines 1-3) and therefore provides beneficial and enhanced effects to the user.

24. Based on the teachings of Russell, it would have been obvious to one having ordinary skill at the time the invention was made to have utilized a deformable grip surface with the Maki device in addition to the non-slip grip already taught by Maki in order to provide a better and more enhanced level of exercise to the user which greatly increases the functionality and versatility of the device.

25. Claims 31, 33, and 34 rejected under 35 U.S.C. 103(a) as being unpatentable over Martin in view of Russell as applied to claim 23 above, and further in view of Russell (US Pat. No. 4,253,661), herein referred to as Russell '661.

26. Martin modified supra fails to disclose inserts that provide the grip.

27. Russell '661 discloses an exerciser for engagement by a user's feet and teaches the use of specifically shaped members (24, 30, 52, 63, 64) that fit into cutouts, which,



absent further limitation and as broadly claimed, comprehend Applicant's 'inserts'. The different members/inserts possess different qualities and characteristics, particularly their shape and density, which permit the user to quickly and easily vary the exercises being performed and the benefits derived therefrom by readily changing the member/insert used during exercise.

28. Therefore, based on the teachings of Russell '661, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized inserts with the Martin device in order to provide a means of readily modifying the device in order to provide different ways of exercising, thereby adding greater functionality to the device while also obviating the need for several different devices to be used in order to attain the provided effects.

29. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin, Russell, and Russell '661 as applied to claims 23 and 31 above, and further in view of Janzen (US Pat. No. 6,185,844), Oakley (US Pat. No. 4,864,740), and Schwitters (US Pat. No. 3,874,100).

30. Martin modified supra fails to disclose the inserts being disposable. However, the use of disposable articles, particularly articles used during exercise or rehabilitative activity when the user is likely to perspire, is well known in order to maintain a high level of cleanliness and sanitation. Furthermore, the use of disposable articles, and particularly inserts, that are in contact with a user's foot is well known as evidenced by Janzen, Oakley, and Schwitters. Therefore, it would have been obvious to an artisan of

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ordinary skill to have utilized disposable inserts with Martin modified supra in order to make the device more hygienic and permissible for ready and easy use by multiple or subsequent users without the worry or threat of spreading germs, bacteria, and the like.

31. Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin in view of Russel as applied to claims 23 and 43 above, and further in view of Takizawa et al. (US Pat. No. 6,780,142).

32. Martin modified supra fails to disclose an open aspect to receive an Achilles tendon of an ankle.

33. Takizawa discloses a lower limb exerciser with, as best understood and as broadly claimed, an 'open aspect' (4) to receive an Achilles tendon of an ankle (note Figure 6). Takizawa teaches the device being used for exercise and rehabilitation after injury to the foot, and specifically the Achilles tendon (column 29, lines 3-10).

34. Based on the teachings of Takizawa, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized an open aspect to receive an Achilles tendon of a user's ankle with the Martin device in order to enable the device to be further used for exercising or rehabilitation, particularly the region of the Achilles tendon, which greatly increases the functionality and versatility of the device.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allana Lewin whose telephone number is 571-272-5560. The examiner can normally be reached on Monday-Friday, 9AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on 571-272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AL   
August 18<sup>th</sup>, 2006

  
STEPHEN R. CROW  
PRIMARY EXAMINER  
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